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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/234,208 01/20/99 DOHERTY

J 49321-1

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HM12/0329

EXAMINER

NICHOLS, J

ART UNIT

PAPER NUMBER

1642

DATE MAILED:

03/29/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/234,208

Applicant(s)

Doherty et al.

Examiner

Jennifer Nichols, Nee Hunt

Group Art Unit

1642



- ☐ Responsive to communication(s) filed on _____
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 1 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

- ☒ Claim(s) 1-26 _____ is/are pending in the application.
- Of the above, claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☐ Claim(s) _____ is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☒ Claims 1-26 _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
- ☐ received.
- ☐ received in Application No. (Series Code/Serial Number) _____
- ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

- ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- ☐ Notice of References Cited, PTO-892
- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☐ Interview Summary, PTO-413
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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Election/Restriction

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-3, and 8-10, drawn to an isolated polypeptide, classified in class 530, subclass 350.
 - II. Claims 4-7, and 11-13, drawn to DNA, and corresponding host cell transfected with corresponding vector, classified in class 536, subclass 23.5, class 435, subclass 320.1 and 70.1.
 - III. Claims 14-20, drawn to a method of treating a solid tumor, classified in class 424, subclass 181.1 and 277.1.
 - IV. Claims 21-23, drawn to a method of targeting a therapeutic agent to a tumor, classified in class 424, subclass 181.1 and 277.1.
 - V. Claims 24-26, drawn to a method of determining prognosis of tumor treatment, classified in class 435, subclass 7.1.
2. The inventions are distinct, each from the other because of the following reasons:

The inventions of Groups I and II are completely different products, having different structures, different functions, and distinct biological activities.

Inventions of Group I and Groups III-V are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the

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process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the product of Group I can be used for materially different processes, such as to raise antibodies.

The inventions of Groups III-V are completely different methods, having different starting points, different method steps, and distinct outcomes. The method of group III treats a tumor with a polypeptide binding agent, the method of Group IV targets a therapeutic agent to a tumor by attaching the therapeutic agent to a polypeptide, and the method of Group V measures prognosis by determining levels of polypeptide expression.

3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

4. Because these inventions are distinct for the reasons given above and the search required for any one Group is not required for any other Group, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently

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named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jennifer Nichols, whose telephone number is (703) 308-7548. The examiner can normally be reached Monday through Thursday 6:30am to 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paula Hutzell can be reached at (703) 308-4310. The fax number for the group is (703) 305-3014 or (703) 308-4242.

Communications via internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [paulahutzell@uspto.gov].

All internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists the possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the group receptionist, whose telephone number is (703) 308-0196.

Jennifer Nichols, Nee Hunt

March 27, 2000

Yvonne E. Eber
YVONNE EBER, PH.D.
PRIMARY EXAMINER